

such words as “substantially,” “approximately,” or the like, without rendering his claims indefinite. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983); *In re Mattison*, 509 F.2d 563, 184 U.S.P.Q. 484 (CCPA 1975); *Ex parte Sobin*, 139 USPQ 528 (POBA 1968). Claims are to be read in light of the specification, particularly for the purpose of interpreting the meaning of words used by the applicant. *See Seattle Box Co. v. Indus. Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984); *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976).

In regard to claim 29, it is impossible to define the size of a hand since hands do not come in specific sizes. Further, it would be inappropriate to limit the claim to any particular size of hand. The breadth of a claim should not be equated with indefiniteness. *See In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). The essential inquiry is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” MPEP 2173.02. “The definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” MPEP 2173.02. In the instant case, one with ordinary skill in the art would understand what is meant by “fits both large and small hands comfortably.” This language provides as much clarity and particularity as is permitted under the circumstances since there is no way to place any kind of quantitative measurement on “large and small hands.” If Examiner still believes that the claim is indefinite, then Applicants would request that Examiner suggest claim language that would improve the clarity or precision of the language used without unduly narrowing the scope of the claim. MPEP 2173.02.

CLAIM REJECTIONS--35 U.S.C. § 102

Examiner rejected claims 1-2, 4, 8-12, 14-16, 20-24, and 27-30 under 35 U.S.C. § 102(b) as being anticipated by *Atkinson* (U.S. Pat. No. 5,705,212). This rejection is respectfully traversed.

In the Office Action, Examiner states as follows:

Atkinson teaches a container comprising a food product (Figure 1, #16), a collectible spoon (Figure 1, #22), a cylindrical receptacle including a handgrip region (Figure 1, #12), a removable cap capable of acting as a cup or bowl (Figure 1, #14), a removable seal (Figure 1, #21), a lip and groove providing a snap-fit (Figure 1, #20), and a collar (Figure 1, #14b).

(Office Action dated 05/25/2004 at 6.) With all due respect, *Atkinson* does not teach the elements of the invention as stated by Examiner. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Examiner claims that *Atkinson* teaches a “collectible spoon (Figure 1, #16).” Yet, nowhere does *Atkinson* teach that the spoon is “collectible.” The only purpose disclosed for the spoon in *Atkinson* is its normal purpose, a tool for eating the product within the container. The Examiner is not permitted to read terms into the prior art or interpret the prior art in a manner that is inconsistent with how one with ordinary skill in the art would interpret the prior art. The spoon in *Atkinson* is not a “collectible” but a functional item. The spoon is not a “promotional item” as that term is defined in the present invention. Because *Atkinson* does not disclose or suggest a container having a “promotional item wherein said promotional item is not comprised of food” as claimed in claims 1 and 14, the present invention is not anticipated by *Atkinson*. The spoon disclosed in

Atkinson cannot be reasonably interpreted as a promotional item since there is nothing promotional about it.

Claim 1, as amended, reads as follows:

1. A container for holding a plurality of items for use by a consumer, said container comprising:
 - a food product;
 - a promotional item wherein said promotional item is not comprised of food;
 - a receptacle for holding said food product, said receptacle having a first end and a second end; and
 - a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle, and wherein said container is shaped such that it is portable.

(Claim 1.) With reference to **Figure 11**, Applicants describe an embodiment of the invention with a “promotional item”:

Figure 11 illustrates a container for holding multiple products in separate compartments in which a pouch is used to hold one of the products inside the cap. . . . Another use of the multi-functional container, for example, is to place food product in the receptacle **1120** of the container while placing a promotional item such as a prize, a toy, a ball, a contest item, a collectible, a coupon, or other non-food item inside a pouch **1130** to be held inside the cap **1110** when the cap **1110** is mated with the receptacle **1120**. Although a pouch **1130** is illustrated for holding the promotional item, the pouch is not necessary. The promotional item can also be placed directly inside the cap **1110** without a pouch or covering. The advantage of placing the promotional item **1130** in the cap rather than in the receptacle **1120** of the container along with the food product is that the food product is kept out of direct or indirect contact with the promotional item **1130** by the membrane or seal **1140** on the receptacle **1120**. Thus, any concerns about contamination of the food product by the promotional item **1130** are alleviated. This reduces the cost of compliance with federal regulations regarding items in direct or indirect contact with food products. Prior art containers having promotional items inside the container have placed them either in direct or indirect contact with the food product. The present invention, however, allows the promotional pieces to be placed inside a portable container while keeping the promotional pieces separated from the food product. Furthermore, the present invention allows the volume of the food product in the main body of the container to remain unchanged during a promotional campaign. In prior designs, either the

volume of the product must be reduced, or the container size must be increased when a promotional piece is inserted to maintain the same volume of product.

Although the container in **Figure 11** illustrates a single prize being placed inside the cap **1110**, the invention is not limited to a single cap or a single prize, nor is the particular shape of the cap limited to that shown. In another embodiment, two caps could be placed on each end with food products and/or promotional items in each cap, or a cap can be placed on one end and a molded prize attached to the other end. For example, in addition to placing a prize or food product inside the cap **1110**, another prize that is molded to fit the base of the receptacle **1120** could be removably attached directly to the bottom of the container to form part of the overall shape of the container. This prize could be, for example, an injection molded stencil toy that could be removed by a consumer and a picture drawn by the consumer marking through the stencil onto a piece of paper. In such an embodiment, the portability of the container is maintained while also keeping the food product separate from the promotional items.

(Spec. at 21-22.) As can be understood from the above description, the “promotional item” is just what the term suggests. The promotional pieces that are placed in the container are not used to aid in the consumption of the product in the container but as a promotion that would, for example, help advertise or sell the products. Children and teenagers will often buy a product because of the promotional items that come with that product. A spoon is not such a promotional item.

One of the advantages of the present invention is that the “promotional item” is kept separate from the food product in the receptacle portion of the container. This provides advantages over the prior art in that (1) any concerns about contamination of the food product by the promotional item are alleviated, thus reducing the cost of compliance with federal regulations regarding items in direct or indirect contact with food products, and (2) the present invention allows the volume of the food product in the main body of the container to remain unchanged during a promotional campaign. In prior designs, either the volume of the product must be reduced, or the container size must be increased when a promotional piece is inserted to maintain the same volume of product.

In *Atkinson*, there is no need to keep the spoon separate from the product because the spoon is used to consume the product. Further, *Atkinson* anticipates that the spoon will always be included with the product rather than including the spoon only during promotional campaigns as disclosed in the present invention. Because *Atkinson* does not disclose a container with a promotional item, claims 1-2, 4, 8-12, 14-16, 20-24, and 27-30 are not anticipated by *Atkinson*.

In regard to claims 4 and 16, as discussed above, the spoon is not a “collectible.” A collectible is defined in the dictionary as “an object that is collected by fanciers.” The spoon of *Atkinson* is not a collectible, nor is it a prize, a toy, a coupon, a ball, or a contest item as claimed in claims 4 and 16. Therefore, claims 4 and 16 are not anticipated.

In regard to claims 8 and 20, *Atkinson* does not disclose a cap that “is seatable on said first end of said receptacle such that said cap is usable as a bowl for holding said food product during consumption.” Examiner cites to reference numeral 14 of Figure 1 as support for the argument that claims 8 and 20 are anticipated by *Atkinson*. Yet, nowhere does *Atkinson* disclose that the “cover 14” can act as a bowl for consuming the product. In fact, it appears that the cover 14 could not be seated on the first end of the receptacle and used as a bowl because it is too shallow. Because there is no suggestion or discussion of the use of the cover as a bowl in *Atkinson*, claims 8 and 20 are not anticipated.

In regard to claim 15, *Atkinson* does not teach a removable cap that seats in the opening of the container when “inverted from a closed position over said opening, thus acting as a cup and sealing said first end.” For the same reasons argued in regard to claim 8, claim 15 also is not anticipated. Further, *Atkinson* does not teach that the cover 14 can act as a cup and seal the opening of the container as is claimed in claim 15.

In regard to claim 28, *Atkinson* does not teach a container with a receptacle that “has a curved, generally cylindrical shape for providing a hand grip for said consumer.” In fact, there are no curves in the receptacle disclosed by *Atkinson*. Therefore, claim 28 is not anticipated.

In regard to claim 29, *Atkinson* does not teach a container with a “curved, generally cylindrical shape” that “fits both large and small hands comfortably. There are no curves in the receptacle disclosed by *Atkinson*. Therefore, claim 29 is not anticipated.

In regard to claim 27, Applicants would point out that the intended use recitations and other types of functional language in the preamble cannot be entirely disregarded. MPEP 2111.03. If the intended use or functional language results in a structural difference between the claimed invention and the prior art, the Examiner should give patentable weight to those recitations in the preamble. In the instant case, the use of the container for holding a solid food product while simultaneously holding a promotional item separate from the food product does result in structural differences from the prior art that should be considered by Examiner.

None of the prior art references cited by Examiner in support of the 102 rejections disclose a container with a promotional item as is claimed by the present invention. Because the references do not disclose a container that holds a promotional item inside the container, but separate from the food product, the present invention is not anticipated.

Examiner rejected claims 27-29 under 35 U.S.C. § 102(e) as being anticipated by *Miller* (U.S. Pat. No. 6,474,494). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Miller teaches a portable container comprising a cylindrical receptacle for holding a first food product in the form of a beverage (Figure 1, #18), a removable cap over a first end of the receptacle which acts as a bowl (Figure 1, #14), a removable seal (Figure 1, #12), the cap containing promotional products such as chips and dip (column 4, line 44), the receptacle containing a beverage (column 4, line 18), the receptacle having a hand grip (Figure 1), and a collar (Figure 1, #14BB).

(Office Action dated 05/25/2004 at 3.)

In regard to *Miller*, Examiner states that the cap contains “promotional products such as chips and dip (column 4, line 44).” Chips and dip are food products and are not promotional items as is claimed by the present invention. Food products are expressly excluded from being a promotional item in claim 27. Notice that the specification, reproduced above, makes a distinction between food products and promotional items. In fact, that was an object of the present invention, to keep the promotional item separate from the food product but still within the overall container. Thus, a food product is not equivalent to a promotional item as those terms are used by Applicants.

Further, *Miller* discloses, “The bowl is utilized for finger foods such as chips or dip etc.” *Miller* teaches using the bowl to consume a food product but does not teach a resealable cap that is shaped for holding a promotional item separate from a food product, nor does he teach that the cap can be used as a bowl. In fact, *Miller* teaches that the bowl 14 is not the cap but is simply affixed to the container. A separate cover 12 is used on the beverage container 18. The present invention in claim 27 claims that the removable cap can both hold the promotional item inside the cap and mate with the receptacle to close the container. Therefore, *Miller* does not anticipate claims 27-29.

In regard to claim 28, *Miller* does not teach a container with a receptacle that “has a curved, generally cylindrical shape for providing a hand grip for said consumer.” In fact, there are no curves in the receptacle disclosed by *Miller*. Therefore, claim 28 is not anticipated.

In regard to claim 29, *Miller* does not teach a container with a “curved, generally cylindrical shape” that “fits both large and small hands comfortably.” There are no curves in the receptacle disclosed by *Miller*. Therefore, claim 29 is not anticipated.

Examiner rejected claims 27-29 under 35 U.S.C. § 102(e) as being anticipated by *Lee et al.* (U.S. Pat. No. 6,068,865). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Lee et al. teach a portable container comprising a cylindrical receptacle for holding a first food product (Figure 1, #30), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #20), a removable seal (Figure 1, #32), the cap containing promotional products such as chocolate (Figure 2, #24), the receptacle containing yoghurt (Figure 2, #34), the receptacle having a shape that provided a hand grip (Figure 1, #30), the cap having a collar or rim (Figure 1, #20), and the cap being transparent (column 6, line 30).

(Office Action dated 05/25/2004 at 3-4.) With all due respect, *Lee et al.* do not teach the elements of the invention as stated by Examiner. Examiner must show that every single identical element claimed is disclosed in the prior art reference arranged as they are in the claims. Here, there are a number of distinctions between the rejected claims and *Lee et al.*

First, *Lee et al.* do not disclose a container having a promotional item. As discussed above in regard to the *Miller* reference, a food product is not equivalent to a promotional item as those terms are used by Applicants and as specifically stated in claim 27. Examiner states that *Lee et al.* teach a “cap containing promotional products such as chocolate.” Chocolate is a food product that is meant to be consumed. It is not a promotional item as is claimed by the present invention in claim 27 for the same reasons argued above in regard to the *Miller* reference. Thus, *Lee et al.* do not anticipate claims 27-29.

In regard to claim 28, *Lee et al.* do not teach a container with a receptacle that “has a curved, generally cylindrical shape for providing a hand grip for said consumer.” In fact, there are no curves in the receptacle disclosed by *Lee et al.* Therefore, claim 28 is not anticipated.

In regard to claim 29, *Lee et al.* do not teach a container with a “curved, generally cylindrical shape” that “fits both large and small hands comfortably. There are no curves in the receptacle disclosed by *Lee et al.* Therefore, claim 29 is not anticipated.

Examiner rejected claims 27-30 under 35 U.S.C. § 102(b) as being anticipated by *Le Rose* (U.S. Pat. No. 2,076,132). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Le Rose teaches a portable container comprising a cylindrical receptacle for holding a first food product in the form of a beverage (Figure 1, #7), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #15), a removable seal (Figure 2, #13), the cap containing promotional products such as ice cream (column 2, line 16), the receptacle containing soda (column 1, line 7), the receptacle having a shape that provided a hand grip (Figure 1, #9), the cap having a collar (Figure 1, #19), and the cap having a lip which engaged a groove in the receptacle (column 2, line 25).

(Office Action dated 05/25/2004 at 4-5.) With all due respect, *Le Rose* does not teach the elements of the invention as stated by Examiner. Examiner must show that every single identical element claimed is disclosed in the prior art reference arranged as they are in the claims. Here, there are a number of distinctions between the rejected claims and *Le Rose*.

First, *Le Rose* does not disclose a container having a promotional item. As discussed above in regard to the *Miller* reference, a food product is not equivalent to a promotional item as those terms are used by Applicants and as specifically stated in claim 27. Examiner states that *Le Rose* teaches a “cap containing promotional products such as ice cream.” Ice cream is a food product that is meant to be consumed. It is not a promotional item as is claimed by the present invention in claim 27 for the same reasons argued above in regard to the *Miller* reference. Further, *Le Rose* does not teach keeping the promotional item separate from a food product. Thus, *Le Rose* does not anticipate claims 27-30.

Second, *Le Rose* does not teach a cap with “a lip protruding inward from an outside edge of said cap for engaging a groove on said first end of said receptacle such that said cap and said receptacle are held together securely” as is claimed by the present invention in claim 30. Rather, *Le Rose* teaches that the rim 19 is screw threaded. A thread is not identical to the lip claimed by the present invention. A threaded connection requires more effort and time to remove and replace than does the lip and groove connection claimed by the present invention. Therefore, *Le Rose* does not anticipate claim 30.

Examiner rejected claims 27-30 under 35 U.S.C. § 102(e) as being anticipated by *Nava et al.* (U.S. Pat. No. 6,070,752). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Nava et al. teach a portable container comprising a generally cylindrical receptacle for holding a first food product in the form of a beverage (Figure 1, #8), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #10), the cap containing promotional products such as CD's (Figure 2, # 16), the receptacle containing soda (Figure 1, #9), the receptacle having a shape that provided a hand grip (Figure 1, #8), and the cap having a collar or rim (Figure 1, #23).

(Office Action dated 05/25/2004 at 5.) With all due respect, *Nava et al.* do not teach the elements of the invention as stated by Examiner. Examiner must show that every single identical element claimed is disclosed in the prior art reference arranged as they are in the claims. Here, there are a number of distinctions between the rejected claims and *Nava et al.*

Nava et al. do not teach “a resealable cap for closing said first end of said receptacle and for holding said promotional item, wherein said resealable cap is shaped for holding said promotional item inside said resealable cap while mating with said first end of said receptacle to close said container” as is claimed in claim 27. The cap disclosed by *Nava et al.* does not meet this claim limitation because the CD 16 is held on the outside of the inner member 12 with an

outer member 14. Thus, there are two separate pieces, one for sealing the container 8, and the other for holding the CD 16 to the outside of the inner member 12. The present invention, on the other hand, claims a removable cap that holds the promotional item inside the removable cap without the necessity of a separate special cap for the promotional item. Thus, the container of claim 27 of present invention provides greater utility and ease of construction. The container disclosed by *Nava et al.* would be more expensive to manufacture in that two separate pieces must be made for the closure. Further, the container of *Nava et al.* is not as versatile as the container claimed in the present invention because of the limited space for placing a promotional item. In fact, it appears that the container in *Nava et al.* could only be used for the specific purpose of holding a CD. The container of the present invention can hold promotional items of a variety of shapes and sizes. Therefore, claim 27 is not anticipated by *Nava et al.*

In regard to claim 28, *Nava et al.* do not teach a container with a receptacle that “has a curved, generally cylindrical shape for providing a hand grip for said consumer.” In fact, there are no curves in the receptacle disclosed by *Nava et al.* Therefore, claim 28 is not anticipated.

In regard to claim 29, *Nava et al.* do not teach a container with a “curved, generally cylindrical shape” that “fits both large and small hands comfortably. There are no curves in the receptacle disclosed by *Nava et al.* Therefore, claim 29 is not anticipated.

Therefore, Applicants request that Examiner reconsider the 35 U.S.C. § 102 rejections in light of the foregoing remarks. Applicants request that Examiner either withdraw these rejections or provide a proper basis for the rejection of the claims.

CLAIM REJECTIONS--35 U.S.C. § 103

Throughout the obviousness rejections, it appears that Examiner is focusing only on the particular element claimed in the dependent claim at issue. Applicants would respectfully

remind Examiner that all limitations of the claimed invention must be considered when determining patentability. *See In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). The fact that a claimed element may exist in the prior art does not mean that the claimed combination is obvious in view of the prior art. Examiner must show some suggestion or motivation somewhere in the prior art to make the combination. Applicants request that Examiner indicate the suggestion or motivation that exists in the prior art that would motivate one with skill in the art to make the combination at issue. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141; *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

In determining whether particular references might be properly combined, whether it is obvious to try a combination is not a legitimate test. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). The test is whether the combination of the references or modification would be obvious to **do** rather than obvious to **try**. *In re Deuel*, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210, 1216 (Fed. Cir. 1995). A general incentive does not make obvious a particular result, nor does the mere existence of techniques which may be carried out to achieve the particular result. *Id.* A proper *prima facie* case of obviousness requires that the prior art reveal a reasonable expectation of success carrying out the proposed combination or modification. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Both the suggestion and

the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *Id.*

Examiner rejected claims 5-7 and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over *Atkinson* in view of *Kirshenbaum, et al.*, (US Patent No. 4,051,265). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Atkinson teaches the above mentioned components. Atkinson does not teach an outer layer which carries graphics and provides an oxygen barrier. Kirshenbaum et al teach a container and cap with an outer layer which provided an oxygen barrier (Figure 1, #14; abstract), as well as the use of graphics (column 5, lines 50-62). It would have been obvious to one of ordinary skill in the art to incorporate the outer layer of Kirshenbaum et al into the invention of Atkinson since both are directed to food containers, since Atkinson already included a sealed container (Figure 1, #12 & 21), and since the outer layer of Kirshenbaum et al provided an effective oxygen barrier and thus better preserved the food (abstract). It would have been obvious to one of ordinary skill in the art to include graphics on the outer layer of Kirshenbaum et al since Kirshenbaum et al already included graphics on the container itself (column 5, lines 50-62), since outer layers commonly included graphics, and since graphics on the outer layer would have made the product more distinctive looking and set it apart from its competitors.

(Office Action dated 05/25/2004 at 6-7.) *Atkinson* does not teach the claimed limitations of claims 1 and 14 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. A spoon is not a promotional item. Thus, *Atkinson* does not teach a container comprising “a promotional item . . .” Further, *Atkinson* does not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1 and similarly in claim 14. Furthermore, *Kirshenbaum et al.* do not provide any motivation or suggestion to combine the outer layer claimed in claims 5-7 and 17-19 with the container disclosed in *Atkinson*. Because the combinations claimed in claims 5-7 and 17-19

are not suggested in the prior art and because not all the elements claimed are shown in the prior art, claims 5-7 and 17-19 are not obvious in view of the prior art.

Examiner rejected claims 13 and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Atkinson* in view of *Lee et al.* This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Atkinson teaches the above mentioned components. Atkinson does not recite a transparent region. Lee et al teach a container comprising a transparent region (column 6, line 30). It would have been obvious to one of ordinary skill in the art to incorporate the transparent region of Lee et al into the invention of Atkinson since both are directed to food containers, since Atkinson already included cap with an interior chamber for the spoon (Figure 1, #14), and since the transparent cap of Lee et al would have better displayed the novel spoon of Atkinson, and thus increased consumer appeal.

(Office Action dated 05/25/04 at 7.) *Atkinson* does not teach the claimed limitations of claims 13 and 25 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. A spoon is not a promotional item. Thus, *Atkinson* does not teach a container comprising “a promotional item . . .” Further, *Atkinson* does not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1 and similarly in claim 14. Furthermore, *Lee et al.* do not provide any motivation or suggestion to combine the transparent region in claims 13 and 25 with the container disclosed in *Atkinson*. Because the combinations claimed in claims 13 and 25 are not suggested in the prior art and because not all the elements claimed are shown in the prior art, claims 13 and 25 are not obvious in view of the prior art.

Examiner rejected claim 26 under 35 U.S.C. § 103(a) as being unpatentable over *Atkinson* in view of *Howes* (U.S. Pat. No. 5,076,433). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Atkinson teaches the above mentioned components. Atkinson does not recite a promotional item attached to a second end of the receptacle. Howes teaches a container comprising a promotional item attached to a second end of the receptacle (Figure 1, #21). It would have been obvious to one of ordinary skill in the art to incorporate the bottom attached promotional item of Howes into the invention of Atkinson since both are directed to beverage containers, since Atkinson already included an additional product attached to the first end (Figure 1, #22), since consumers greatly valued promotional items such as prizes, and since the bottom promotional item of Howes has the advantage of providing a prize, while being completely indistinguishable from a non-prize bearing container (column 2, lines 39-48).

(Office Action dated 05/25/04 at 7-8.) *Atkinson* does not teach the claimed limitations of claim 14 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. A spoon is not a promotional item. Thus, *Atkinson* does not teach a container comprising “a promotional item . . .” Further, *Atkinson* does not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1 and similarly in claim 14.

Furthermore, *Howes* provides no motivation or suggestion to combine the promotional item claimed in claim 26 with the container in *Atkinson* to reach the present invention. Examiner has used the benefit of hindsight to argue that the combination is obvious on the basis that each of the prior art references have all the elements of the claimed invention. While Applicants do not agree that all elements are present in the prior art, even if all the elements existed in the prior art, there is no suggestion in the prior art to make the combination suggested by Examiner.

Indeed, Examiner cannot point to a statement in either *Atkinson* or *Howes* that suggests the combination. Just because the combination is better and “consumers greatly value[] promotional items such as prizes,” this does not provide a basis for an obviousness rejection. This only means that the combination is useful, not that it is obvious. Further, as argued above, *Atkinson* does not disclose a container with a promotional item. Contrary to Examiner’s assertion, the container in *Atkinson* is a food container, and not a beverage container, and thus the containers of *Atkinson* and *Howes* are used for two different purposes. Further, the “advantage of providing a prize, while being completely indistinguishable from a non-prize bearing container,” is not a suggestion to make the claimed combination. Therefore, Applicants request that Examiner either point out the suggestion in the prior art to make the claimed combination or allow claim 26.

Examiner rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over *Atkinson* in view of *McDevitt et al.* (U.S. Pat. No. 5,204,130). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Atkinson teaches the above mentioned components. Atkinson does not recite polypropylene. McDevitt et al teach a snap-fit food container made from polypropylene (column 2, line 26). It would have been obvious to one of ordinary skill in the art to incorporate the polypropylene of McDevitt et al into the invention of Atkinson since both are directed to food containers, since Atkinson already teach the use of plastics (column 2, lines 33-40), and since polypropylene was commonly used in food containers as shown by McDevitt et al (column 2, line 26).

(Office Action dated 05/25/04 at 8.) *Atkinson* does not teach the claimed limitations of claim 31 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. A spoon is not a promotional item. Thus, *Atkinson* does not teach a container comprising “a promotional item . . .” Further, *Atkinson* does not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said

removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1 and similarly in claim 14. Furthermore, *McDevitt et al.* do not provide any motivation or suggestion to combine the polypropylene cap and receptacle of claim 31 with the container disclosed in *Atkinson*. Because the combinations claimed in claim 31 are not suggested in the prior art and because not all the elements claimed are shown in the prior art, claim 31 is not obvious in view of the prior art.

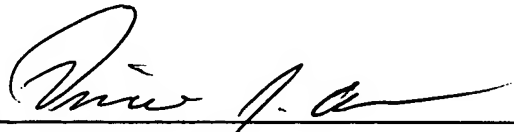
CONCLUSION

Applicants have reviewed the prior art cited by Examiner in the Notice of References Cited of the Office Action and asserts that none of the prior art references, either alone or in combination, are relevant to the patentability of the Applicants’ invention.

If there are any outstanding issues, which the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Vincent J. Allen at 972-367-2001.

Respectfully submitted,

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